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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/943,613

08/30/2001

Alan Goldsmith

D/A0621

9270

7590

05/15/2008

Albert P. Sharpe, III, Esq.
Fay, Sharpe, Fagan, Minnich & McKee, LLP
7th Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

EXAMINER

BEACH, THOMAS A

ART UNIT

PAPER NUMBER

3671

MAIL DATE

DELIVERY MODE

05/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/943,613

Applicant(s)

GOLDSMITH ET AL.

Examiner

THOMAS A. BEACH

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-24 is/are allowed.
- 6) ☒ Claim(s) 1, 3-8 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al 7,171,372 or Abdel-Malek et al 6,959,235 or Moskowitz et al 6,339,736 alone.

Daniel, Abdel and Moskowitz show a method for ordering parts for a machine being serviced within an e-commerce environment, the method comprising: transmitting diagnostic data from a local computing device at the machine to a host computing device via a network; identifying a part to be replaced within the machine as a function of the diagnostic data, wherein when the part is included as a non-replaceable component in a replaceable sub-assembly within the machine, the identifying step further includes, identifying the part as the sub-assembly, and when the part is a replaceable component within the machine, the identifying step further includes, identifying the part as the component (claim 16); determining a part identifier as a function of the part and retrofit information stored on the host computing device; and transmitting the part identifier from the host computing device to an order processing device (fig 1, fig 1, fig 1, respectively). Daniel and Abdel discloses the 132 parts requisition where an updated part identifier would be necessary to order from 3rd party

(col 9, lines 19+) at the parts requisition center 23. Moskowitz also include part identifiers in that are used in order to make parts available through either service desks 302 or dealers 250. Identifying whether a part is part of a subassembly or non-replaceable would be determined upon the basic process of parts requisition, and does not involve a patentable step. This step being performed by the user upon researching the manuals etc or through service desks/dealers is an obvious modification to be automated by computer identifiers and updated identifiers since this modification would have the expected result of quicker lookup time if newly assigned parts identifiers were added to the parts order and would be obvious to one of ordinary skill in the art.

As concerns claims 3 and 16-18, Daniel, Abdel and Moskowitz show determining other parts within the machine to be replaced as a function of the part identifier, since replacing one part in the machine may precipitate changing another part, and any additional parts to be replaced are identified within the retrofit information as a function of the part to be replaced (fig 2-3, fig 4, fig 2, respectively) as modified.

As concerns claim 4, Daniel, Abdel and Moskowitz show including: transmitting an identifier of the machine from the local computing device to a host computing device via the network, the part identifier and the retrofit information being identified as a function of the machine identifier (fig 2-3, fig 4, fig 2, respectively).

As concerns claim 5, Daniel, Abdel and Moskowitz show the local computing device is a discrete unit from the machine, the method further including: connecting the local computing device to the machine via a communication link (fig 2-3, fig 4, fig 2, respectively).

As concerns claims 6 and 19, Daniel, Abdel and Moskowitz show including: storing the diagnostic data within the local computing device (fig 1, 2-3, fig 1, 4, fig 1, 2; respectively).

As concerns claim 7, Daniel, Abdel and Moskowitz show including: transmitting a confirmation to the local computing device that the part identifier has been transmitted to the order processing device (fig 1, 2-3, fig 1, 4, fig 1, 2; respectively)..

As concerns claims 8 and 20-21, Daniel, Abdel and Moskowitz show the identifying step includes: viewing a graphical representation of the machine via a display device; and zooming-in the graphical representation, via a pointing device (fig 4, 170a, 40; respectively).

Allowable Subject Matter

3. Claims 22-24 are allowed.

Response to Arguments

4. Applicant's arguments with respect to the amended claims have been considered but are not persuasive. Applicant's arguments regarding the newly added subject matter related to the updated part identifier and sub-assembly/non-replaceable part(s) have been noted; however, this aspect of use of a known parts identifying system only requires routine skill in the art to modify the process into an automated identifier since parts identifiers and sub-assembly/non-replaceable part(s) are known to be encountered during remote repairs. Processors, host computing, and storage devices are inherent to the apparatuses of Daniel, Abdel and Moskowitz.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas A. Beach

/Thomas A Beach/
Primary Examiner, Art Unit 3671

May 17, 2008

THOMAS A. BEACH
Primary Examiner
Group 3600